

REMARKS

Applicant appreciates the continued thorough examination of the present application as reflected by the non-final Office Action of December 23, 2008 (hereinafter, "the Office Action"). Applicant responds herein to each of the issues newly raised in the Office Action, and respectfully submits that the present application is in condition for allowance for the reasons discussed below.

The Rejections Under 35 U.S.C. § 101

Claims 1, 11, 19, and 31 stand rejected under 35 U.S.C. § 101 as allegedly being "not supported by either a specific and substantial asserted utility or a well established utility." Office Action, page 2. The Office Action specifically contends that "Claims 1, 11, 19 and 31 are non statutory because there is no positively cited specific structure tied to the streaming, the combining, the receiving, and the transmitting steps." Office Action, page 2.

In response, Applicant has amended Claims 1, 11, 19, and 31 to clarify the specific structures to which the streaming, combining, receiving, transmitting, and downloading operations of the present claims are tied. Claim 1, as amended, recites "transmitting by a transmitter," support for which may be found at, for instance, paragraph [0021] of Applicant's Specification. Claims 1, 19, and 31 have been amended to recite that "combining" is accomplished "by a programmed computer processor," as described in, for example, paragraphs [0022] and [0031] of Applicant's Specification. Amended Claims 11 and 31 recite "streaming" and "downloading" accomplished "by a computer network," which finds support in, *e.g.*, paragraph [0021] of Applicant's Specification. Finally, Claim 19, as amended, recites "receiving by a receiver," as discussed in, for instance, paragraphs [0029] and [0030] of Applicant's Specification. No new matter has been added as a result of Applicant's amendments.

Applicant respectfully submits that method Claims 1, 11, 19, and 31, as amended, satisfy the requirements for patentability under § 101 as set forth by *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). Under *Bilski*'s machine-or-transformation test, "an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article." *Bilski*, 545 F.3d at 961. For the reasons detailed below, Applicant respectfully submits that the present claims meet the requirements of both the "machine" and "transformation" prongs of the *Bilski* test.

With respect to the "machine" prong of the machine-or-transformation test, Applicant respectfully submits that the above-quoted amendments to Claims 1, 11, 19, and 31 make clear that each of the recited operations of "streaming," "combining," "receiving," "transmitting," and "downloading" multimedia data is necessarily carried out by, and consequently is tied to, a particular physical structure or machine. Applicant further notes that the recited steps are not properly characterized as "insignificant extra-solution activity" because the machine-dependent operations recited by Claim 1, 11, 19, and 31 lie at the heart of the claimed method. Accordingly, amended Claims 1, 11, 19, and 31, and the dependent claims thereof, meet the requirement of being "tied to a particular machine."

Applicant further respectfully submits that the present claims also satisfy the requirements of the "transformation" prong of the machine-or-transformation test, because each claim recites the transformation of data representing physical objects or substances into a different form. Applicant notes that each of Claims 1, 11, 19, and 31 recites either "multimedia data" or a "multimedia work." Applicant's Specification expressly states that the term "multimedia" may include "analog or digital audio, analog or digital image and/or analog or digital video content." Applicant's Specification, paragraph [0002]. The claim terms "multimedia data" and "multimedia work," therefore, refer to data that represents the electronic equivalent of physical audio, image, and/or video media, such as audiotape, photographic film, and/or videotape. Moreover, Claims 1, 11, 19, and 31 each recites the transformation of such data into a different form. Carrying out the method of Claim 1, for instance, results in the transformation of multimedia data having first resolution by combining it with supplemental data to generate new, higher-resolution multimedia data. Thus, Claims 1, 11, 19, and 31 satisfy the "transformation" prong of the *Bilski* machine-or-transformation test.

Finally, to the extent that the rejections of Claims 1, 11, 19, and 31 are premised upon the Office Action's assertion that "the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility" (Office Action, page 2), Applicant notes that the utility requirement for patentability under § 101 is presumed to have been met at the time of filing. "A specification disclosure which contains a teaching of... using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance [with the utility requirement] *unless* there is reason to doubt the objective truth of the statements contained

therein which must be relied on." *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (original emphasis) (quoting *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971)). Applicant's Specification expressly describes the use and utility of some embodiments of the claimed subject matter in, e.g., paragraphs [0045]-[0057], and the Office Action does not provide any basis to doubt the truth of the objective statements therein.

For at least the foregoing reasons, Applicant respectfully submits that Claims 1, 11, 19, and 31 are directed to statutory subject matter, and requests the withdrawal of the rejections under § 101.

The Rejections Under 35 U.S.C. § 103(a)

Claims 1-7, 9-28, 30-46, and 48-67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,266,817 to Chaddha ("Chaddha") in view of U.S. Patent No. 6,639,943 to Radha et al. ("Radha"). Applicant notes that these rejections correspond to the rejections in the previous Office Action of September 3, 2008. Accordingly, to expedite the Examiner's consideration of these rejections, only the issues newly raised in the present Office Action will be discussed herein. However, to ensure that this submission is considered fully responsive to the present Office Action, Applicant's previous Request for Reconsideration of September 24, 2008 ("Previous Request") is incorporated herein by reference as if set forth in its entirety.

A. Independent Claims 1, 11, 41, and 49 Are Patentable

In response to the arguments regarding the patentability of Claims 1, 11, 41, and 49 presented in Applicant's Previous Request, the Office Action states as follows:

The applicant presented several arguments to show that Chaddha does not meet the limitations of 'wherein separately transmitting supplemental data is not performed in real time or near realtime'. However, the applicant did not make any argument with respect to Radha ... which was introduced to show Radha providing a multimedia distribution method including the step of not performing in real-time or near real-time the separate transmission of supplemental data (See Radha col. 6, lines 63-67, col. 7, lines 1-12).

Office Action, page 3.

Applicant respectfully submits that the Office Action misapprehends Applicant's argument with respect to Chaddha. Applicant's point regarding Chaddha is that, rather than

merely silent being about real-time transmission of multimedia data and separate, non-real-time transmission of supplemental data, Chaddha actually teaches away from such transmissions. Chaddha likewise actually teaches away from streaming a first portion of a multimedia work and downloading a second portion of the multimedia work. Instead, Chaddha appears to teach a system within which the base layer data (corresponding to the "multimedia data having a first resolution" of Claim 1) and error data (corresponding to Claim 1's "supplemental data") are both streamed together as prioritized packets within "a single embedded information stream." See Chaddha, column 4, lines 36-37 (emphasis added); see also, e.g., column 4, lines 48-49 ("the single embedded information stream"); column 5, lines 57-58 ("the embedded bit-stream generated by the scalable video encoder"); column 7, lines 14-15 ("an embedded prioritized bit-stream"); column 7, line 35 ("the transmitted embedded stream"); column 9, line 2-3 ("the incoming embedded stream"); column 9, lines 21-24 ("video encoder 60 provides a single embedded stream from which different streams at different spatial and temporal resolutions and different data rates can be extracted by decoders 40, depending on decoder capabilities and requirements"); column 11, lines 7-8 ("[a] separate network stream per destination."). Applicant respectfully submits that Chaddha's streaming base layer data and error data within a single embedded stream is completely contrary to transmitting multimedia data in real- or near-real-time and separately transmitting supplemental data in non-real-time (as recited by independent Claims 1 and 41), as well as to streaming a first portion of a multimedia work and downloading a second portion of the multimedia work (as recited by Claims 11 and 49).

Because Chaddha in fact teaches away from the recitations of Claims 1, 11, 41, and 49, it would not be obvious to one of skill in the art to combine Chaddha with any other reference that contradicts its basic teachings. See, e.g., *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (U.S. 2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.") (citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966)). Accordingly, Claims 1, 11, 41, and 49, and the dependent claims thereof, are patentable over Chaddha in view of Radha for at least these foregoing reasons.

Moreover, the Office Action's statement on page 3 that "the applicant did not make any argument with respect to Radha" is incorrect. In fact, Applicant explicitly notes on pages 4-5 of the Previous Request that, while the cited portion of Radha states that streams 31 and

32 can be combined to produce a single stream or can be maintained as two separate streams, the cited passage expressly notes that in "[e]ither case, the resulting FGS stream(s) can be stored or transmitted in real-time." In other words, the cited portion of Radha clearly states that both types of data are streamed and/or transmitted in real-time. The cited passage also indicates that the video signal (both enhancement and base layers) can be transmitted in real-time or off-line. If off-line, the video can be stored and then transmitted (or streamed) at a later time. Again, however, the first and second streams are both transmitted in real-time and are both streamed. Accordingly, Applicant respectfully submits that Radha does not supply the teachings missing from Chaddha, but instead is completely consistent with Chaddha in terms of streaming both streams in real-time. Thus, even if one of skill in the art were to combine the teachings of Radha with those of Chaddha, the resulting combination would still fail to disclose or suggest all of the recitations of the pending claims.

Thus, Claims 1, 11, 41, and 49, and the dependent claims thereof, are patentable over Chaddha in view of Radha for at least these additional reasons. Applicant respectfully requests that, to the extent that the rejections of the present claims are premised upon the Office Action's failure to consider Applicant's arguments regarding Radha, such rejections be withdrawn.

B. Claims 19, 24, and 31-34 Are Patentable

Claims 19, 24, and 31-34 are patentable for at least the same reasons that were described above with respect to Claims 1, 11, 41, and 49, and additionally for at least the reasons presented in Applicant's Previous Request and incorporated herein by reference. For the sake of brevity, this analysis will not be repeated here.

C. Claims 20-21, 53-54, and 60 Are Patentable

Claims 20-21, 53-54, and 60 are patentable for at least the same reasons that were described above with respect to Claims 1, 11, 41, and 49, and additionally for at least the reasons presented in Applicant's Previous Request and incorporated herein by reference. For the sake of brevity, this analysis will not be repeated here.

D. Claims 2-3, 12-13, 48, 50, 54-56, and 61-63 Are Patentable

Claims 2-3, 12-13, 48, 50, 54-56, and 61-63 are patentable for at least the same reasons that were described above with respect to Claims 1, 11, 41, and 49, and additionally for at least the reasons presented in Applicant's Previous Request and incorporated herein by reference. For the sake of brevity, this analysis will not be repeated here.

E. Claims 5, 26, and 43 Are Patentable

Claims 5, 26, and 43 are patentable for at least the same reasons that were described above with respect to Claims 1, 11, 41, and 49, and additionally for at least the reasons presented in Applicant's Previous Request and incorporated herein by reference. For the sake of brevity, this analysis will not be repeated here.

F. Claims 6, 7, 15, 16, 27, 28, 38, 39, 45, 46, 51, 52, 58, 59, 66, and 67 Are Separately Patentable

These dependent claims are patentable at least per patentability of the independent claims from which they depend. Moreover, these dependent claims are separately patentable for at least the reasons presented in Applicant's Previous Request and incorporated herein by reference. For the sake of brevity, this analysis will not be repeated here.

G. Dependent Claims 9 and 17 Are Separately Patentable

Claims 9 and 17 are patentable at least per the patentability of independent Claims 1 and 11, respectively, from which they depend. Further, Claims 9 and 17 are separately patentable for at least the reasons presented in Applicant's Previous Request and incorporated herein by reference. For the sake of brevity, this analysis will not be repeated here.

H. Dependent Claims 10, 18, 30, and 40 Are Separately Patentable

Claims 10, 18, 30, and 40 are patentable at least per patentability of independent Claims 1, 11, 19, and 31, respectively, from which they depend. Claims 10 and 30 are also separately patentable for at least the reasons presented in Applicant's Previous Request and incorporated herein by reference. For the sake of brevity, this analysis will not be repeated here.

I. Dependent Claims 22-23, 35-36, 42, and 64 Are Patentable

Claims 22-23, 35-36, 42, and 64 are patentable at least per patentability of the claims from which they depend.

J. Dependent Claims 4, 14, 25, 37, 44, 57, and 65 Are Patentable

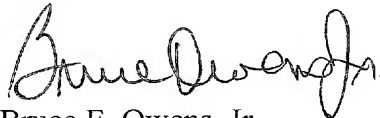
Claims 4, 14, 25, 37, 44, 57, and 65 are patentable at least per patentability of the independent claims from which they depend.

Conclusion

Applicant again appreciates the Examiner's continued thorough examination of the present application. Applicant, however, has demonstrated that the primary reference, Chaddha, actually teaches away from the recitations of the pending claims, and that secondary reference Radha fails to supply the teachings missing from Chaddha.

Accordingly, Applicant respectfully requests allowance of the pending claims and passing the application to issue. Applicant encourages the Examiner to contact the undersigned by telephone to resolve any remaining issues.

Respectfully submitted,



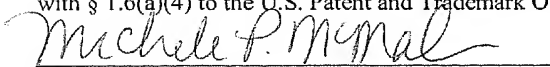
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Date of Signature: March 20, 2009